

Background

On June 3, 1997, the Patent Office issued the applicants' patent no. 5,635,235. On June 3, 1999, the applicants filed their parent reissue application (hereafter simply "parent application"). In support of the parent application, each of the three inventors signed a Reissue Application Declaration (form PTO/SB/51). As provided by the PTO's form, the inventors broadly stated

stating by checking the appropriate box that:

I verily believe the original patent to be wholly or partly inoperative or invalid, for the reason described below. (check all boxes that apply):

/X/ by reason of the patentee claiming more or less than he had the right to claim in the patent.

The Reissue Application Declaration (form PTO/SB/51) also invited the inventors to describe "at least one error upon which reissue is based." (emphasis added) In that section, as requested, the inventors noted that:

The claims directed to a "Diverter Gate" are too narrow.

As required by 35 U.S.C. 251, therefore, the patentee notified the public within two years of the patent's issuance that it sought to broaden the claims of its patent.

On December 29, 2000, during the co-pendency of the parent application, the patentee determined that it had claimed "less than he had the right to claim in the patent" in respect to areas other than as to the diverter gate. In particular, some of the claims required a hopper with a pair of side walls and a bottom wall since, and an infringer was asserting that its product does not infringe because it included a hopper that was created with a pair of slanted side wall and no bottom wall.

On December 29, 2000, the applicants could have simply continued to prosecute the parent application by filing a Continued Prosecution Application (CPA). In such case, the parent application's declarations would obviously have been compliant with 37 CFR 1.175(a)(1). Instead, however, the patentee elected file a continuation application so that the parent application could issue without delay (it ultimately issued as RE37008).

On January 2, 2001, the parent application matured into Reissue Patent RE37008.

As a result of that purely procedural step of choosing to issue the parent while filing a continuation, in a true "form over substance" manner, the Patent Office is now asserting that the parent application's declarations are inadequate for use in the continuation application and that, regardless of the resolution of that issue, that the continuation application is a "separate" application and that 35 USC 251 prohibits claims from being broadened in a reissue application filed outside the two-year statutory period.

Applicant respectfully traverses.

Reissue Declaration

The Office Action, at paragraphs 1 to 2, contends that this continuation application is defective because the error relied on to support this continuation application does not comply with 37 CFR 1.175(a)(1). The first paragraph then refers applicant to Paragraph No. 7, Paper No. 7, where the Examiner contends that:

The error identified in the reissue declaration applies only to the parent reissue. A different error that applicant relies upon to support the instant continuation reissue

application must be identified in a supplemental reissue declaration.

The prior Office Action, in other words, asserts that the continuation application cannot rely on the parent application because the error identified in the parent application's declarations is different than the error being addressed in this continuation application.

As invited by the PTO's own form, however, each inventor broadly stated by checking the appropriate box that:

I verily believe the original patent to be wholly or partly inoperative or invalid, for the reason described below. (check all boxes that apply):

/X/ by reason of the patentee claiming more or less than he had the right to claim in the patent.

Clearly the claims at issue in this continuation application could have been supported by these broad declarations had the patentee added them to the parent application. The patentee respectfully submits, therefore, that parent's declarations are equally adequate to support these claims in its continuation application.

35 USC 251 As Applied to a Continuation Application

In relevant part, 35 U.S.C. 251 of the United States Patent Law provides as follows:

No reissued patent shall be granted enlarging the scope of the claims of the original patent unless applied for within two years from the grant of the original patent.

Based on this language, the Office Action asserts at paragraphs 4 and 5 that applicants' continuation application does not comply with 35 U.S.C. 251 because it

was filed after the two-year period. What the Office Action fails to properly consider, however, are the facts that:

- (1) the parent application was filed within the two-year period; and
- (2) the continuation application claims priority to the parent application under 35 U.S.C. 120.

This situation is controlled by 35 USC 120 because it provides in relevant part that:

An application for patent *** which is filed by an inventor or inventors named in the previously filed application shall have the same effect, as to such invention, as though filed on the date of the prior application, if filed before the patenting or abandonment of or termination of proceedings on the first application *** if it contains or is amended to contain a specific reference to the earlier filed application.

In short, there is no legal difference between an earlier-filed application that is prosecuted for a long time with different claims added along the way (as in In re Doll), and a continuation application that claims priority to the earlier-filed application under 35 U.S.C. 120. This case, in other words, is legally on all fours with In re Doll.

Applicant respectfully asks, therefore, that the Examiner reconsider In re Doll where the Patent Office was reversed on nearly identical assertions regarding the reissue oath and the 35 USC 251 time limit. In the In re Doll decision, like the Examiner here, the Patent Office contended that appellant's reissue oath was defective as follows:

Patent Office Rule 175 requires the reissue oath to particularly specify the errors relied upon, which appellant has done in this case by referring particularly to Fig. 4 in his oath, and the fact that he had failed to claim the invention in the breadth set forth in claims 20 to 31, inclusive. Thus, it appears that the two-year period in which to file for broadened reissue claims is granted for the purpose of enabling the patentee to discover particular deficiencies in the breadth of the claims as originally granted, and not as a

period in which to decide whether or not he should spread a net to catch any broad subject matter which he may later decide should have been captured.

The appellant in In re Doll filed broadening claims 20-31 prior to the two-year period, submitting a supporting reissue declaration that stated that:

None of the patent claims afford for the embodiment of Fig. 4 patent coverage of the scope possessed by claims 20-31, inclusive, which form part of the foregoing specification, nor were claims of comparable scope ever presented during the pendency of the original application on which said Letter Patent were granted.

In re Doll, page 220.

Later, after more than two-years had passed since the patent issued, the appellant added even **broader** claims, not once, but twice. The CCPA notes, however, that even though the later filed reissue application claims were even broader than the first-filed reissue application claims 20-31, the ones explicitly referenced in the reissue declaration, the reissue declaration was sufficient to support all of the reissue application claims. The same should be true here.

In addition, after the CCPA reviewed the congressional rationale behind the two-year provision of 35 U.S.C. 251, it held that there was nothing whatsoever in the legislative history that supported the Patent Office's assertion that section 251 precluded a reissue applicant from introducing further broadening claims after two-years:

We are unable to ascertain from the [legislative history] any intent similar to the interpretation placed on Section 251 by the board.

In re Doll, page 220:


The Examiner is advancing the same interpretation of section 251 that was unsuccessfully advanced by the Patent Office in In re Doll. The only factual difference is that the application here is a second application in a chain, rather than one continuously prosecuted application. As already explained, however, it makes no difference that this is a continuation application because 35 USC 120 requires that it be treated exactly as if it were the application from which it claims priority.

Based on the foregoing, Applicant respectfully submits that this reissue application is ready for allowance. Applicant respectfully attends to address this issue on appeal, if necessary. Applicant invites the Examiner to telephone the undersigned attorney right away if it appears that a telephone conference would further this case in any way.

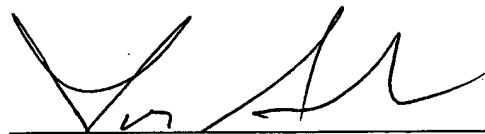
I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: **Box Reissue, Assistant Commissioner for Patents, Washington, DC 20231** on

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By Angela Williams


Signature
November 21, 2002

Respectfully submitted,



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